

REMARKS

Introduction

Claims 1-20 were originally pending in this application. Claims 1-20 remain pending for consideration in this application.

Claim Rejections

35 U.S.C. §103

Claims 1, 3-13, 15-16, and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over published U.S. Patent Application No. 2003/0061104 to Thomson et al. in view of published U.S. Patent Application No. 2003/0167191 to Slabonik et al. Claim 2 was similarly rejected as being unpatentable over the Thomson et al. application in view of Slabonik et al. as applied to claim 1 and in further view of U.S. Patent Number 5,307,262 to Ertel. Claims 19 and 20 were also rejected as being unpatentable over Thomson et al. in view of Slabonik et al. and Ertel. Finally, claims 14 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Thomson et al. in view of Slabonik et al. as applied to claims 13 and 15 respectively, and in further view of published U.S. Patent Application No. 2001/0034722 to Tidball et al. The Applicant cannot agree with the Examiner that the invention claimed would have been obvious to one of ordinary skill in the art in view of these references. Accordingly, for the reason set forth below, the Applicant respectfully traverses these rejections.

The Prior Art

Published U.S. Patent Application No. 2003/0061104 to Thomson et al.

The Thomson et al. publication is directed toward an Internet based system to control warranty and repair service issues for manufactures of consumer products. Specifically, Thomson

et al. discloses a method that employs a third-party warranty administrator (24 in Figure 2) that controls and maintains a plurality of databases. The product information portion 71 of the databases contains manufacturer-supplied information relating to the products sold. The customer information portion 28 of the databases includes personal data and specific information that is supplied by the customer relating to the consumer item and its purchase. The manufacturer predetermines certain allowable actions that may be taken in connection with warranty claims and sets expiration dates. These allowable warranty claim actions are stored in an application server 220 that is accessed by a main electronic warranty administrator application program when a warranty claim is placed.

In this manner, the third-party warranty administrator 24 of the Thomson et al. application places itself, as a service provider, between the manufacture and the customer so that all customer requests for warranty service are handled through the warranty administrator 24. When a warranty claim is submitted, the warranty administrator 24 of the Thomson publication makes a simple computer-based yes/no determination regarding whether or not the item is under warranty and if it will be serviced. The value of the claim is not assessed nor is there a predetermined series of management levels that the claim must move through for approval.

Published U.S. Patent Application No. 2003/0167191 to Slabonik et al.

The Slabonik et al. publication is directed toward a system and method for an underwriting review of insurance policy applications. Specifically, Slabonik et al. discloses a system and method for approving or disapproving the sale of an insurance policy (underwriting) from an insurance carrier to an individual applying for coverage. The Slobonik publication relates solely to making approval or disapproval determinations to sell insurance policies based on the way an application form is filled out and has nothing to do with a warranty claim process for manufactured goods. The

information on the application is automatically reviewed to determine where the individual falls with regard to a predetermined set of defined risks. Based on the level of insurable risk automatically determined from the application form, the application is flagged as “Do not insure” (block 110) or “Referral” (block 112). If flagged “referral”, the insurance application is sent to a secondary underwriter who makes a determination of whether or not to insure the applicant based on other data included on the original application.

However, neither the Thomson et al. nor the Slabonik et al. publications disclose or suggest a method of processing a customer claim against a manufacturer’s product that includes the steps of *determining the value of the claim*, then approving or denying the claim at *the first management level* when the value of the claim is below a first predetermined level. The Thomson et al. and Slabonik et al. publications also do not disclose or suggest *a second management level* that acts to review all claims input at the first management level and which acts to approve or deny the claim when the value of the claim is above the first predetermined level and below a second predetermined level. Further, the Thomson et al. and Slabonik et al. publications do not disclose or suggest *a third management level* acting to review all claims input at the first and second management levels and acting to approve or deny the claim when the value of the claim is above the second predetermined level as required by independent claim 1.

Additionally, the Thomson et al. and Slabonik et al. publications do not disclose or suggest a method for processing a customer claim after the expiration of a specified warranty period including *a fourth management level* to review all approved claims for accuracy and completeness and to inform the customer when a claim is denied as required by independent claim 19. The fourth management levels acting to inform an accounting management level when a claim has been approved and then directs the accounting management level to reimburse the customer. Similarly,

the Thomson et al. and Slabonik et al. publications do not disclose or suggest a *fourth management level* as described above in connection with processing a customer claim for ancillary costs arising from customer expenses associated with the servicing of the product while still within the manufacturer's specified warranty period as required by independent claim 20.

US Patent No. 5,307,262 to Ertel

The Ertel '262 patent is directed to a method for reviewing and controlling the quality of clinical patient data stored in large hospital databases. Specifically, the Ertel '262 process is applied to existing records kept in large database files. Each record within these large hospital databases stores separate patient case information and treatment data. The majority of the information in each record is taken from patient charts and treatment records, then converted to numeric codes, and entered into specific fields on each record.

The Ertel method is used to automatically detect, analyze, and classify the quality and accuracy of the coded patient data stored in the hospital databases, and it does so in a batch, or bulk, processing format. More specifically, it reviews the records in large batches, and looks for data codes that are incorrect for the field they are placed in. However, Ertel does not use separate management levels for the quality review of the hospital databases. If errors are discovered the process simply provides reports to the respective administrative personnel. Further, Ertel has nothing to do with a warranty claim process for customer claims made against manufactured goods. In fact, the Ertel method utilizes bulk processing so that it is incapable of processing individual reports or claims within the hospital database.

Thus, the Ertel '262 patent does not disclose or suggest a method of processing a customer claim against a manufacturer's product that includes the steps of *determining the value of the claim*,

then approving or denying the claim at *the first management level* when the value of the claim is below a first predetermined level. The Ertel '262 patent also does not disclose or suggest having a *second management level* that acts to review all claims input at the first management level and which acts to approve or deny the claim when the value of the claim is above the first predetermined level and below a second predetermined level. Further, the Ertel '262 patent does not disclose or suggest a *third management level* acting to review all claims input at the first and second management levels and acting to approve or deny the claim when the value of the claim is above the second predetermined level as required by independent claim 1.

Additionally, the Ertel '262 patent does not disclose or suggest a *fourth management level* to review all approved claims for accuracy and completeness and to inform the customer when a claim is denied and to inform an accounting management level when a claim has been approved and direct the accounting management level to reimburse the customer with regard to processing a customer claim after the expiration of a specified warranty period as required by independent claim 19. Similarly, the Ertel '262 patent does not disclose or suggest a *fourth management level* as described above in connection with processing a customer claim for ancillary costs arising from customer expenses associated with the servicing of the product while still within the manufacturer's specified warranty period as required by independent claim 20.

Published US Patent Application No. 2001/0034722 to Tidball et al.

The Tidball et al. publication is directed to a method and system for remote activation of a debit/credit card based personal account at a point-of-sale terminal without the transfer of funds. Specifically, Tidball et al. is cited as disclosing a web page button. However, it is respectfully

submitted that Tidball et al. is entirely distinct from the other prior art references as well as the method of the present invention.

In summary, none of the prior art references of record in this case disclose or suggest the methods of processing a customer claim as described in independent claims 1, 19, and 20, including first, second, and third and/or fourth management levels, nor the specific functions performed by these management levels.

The Present Invention

In contrast to the prior art references, the present invention as defined in independent claim 1 is a method of processing a customer claim against a manufacturer's product that includes the steps of inputting the claim through a computer to a database at a first management level, determining the value of the claim, approving or denying the claim at the first management level when the value of the claim is below a first predetermined level. The method includes a second management level that acts to review all claims input at the first management level and to approve or deny the claim when the value of the claim is above the first predetermined level and below a second predetermined level. A third management level acts to review all claims input at the first and second management levels and to approve or deny the claim when the value of the claim is above the second predetermined level.

Independent claim 19 is directed toward a method of processing a customer claim against a manufacturer's product when the claim is made for repair or replacement of the product *after* the expiration of a specified warranty period. Similarly, independent claim 20 is directed toward a method of processing a customer claim against a manufacturer's product when the claim is made *for ancillary costs* arising from customer expenses associated with the servicing of the product while

still within the manufacturer's specified warranty period. Both independent claims 19 and 20 include the limitations set forth in independent claim 1 as described above. In addition, both independent claims 19 and 20 include a fourth management level to review all approved claims for accuracy and completeness and to inform the customer when a claim is denied and to inform an accounting management level when a claim has been approved and direct the accounting management level to reimburse the customer.

Argument

A rejection based on §103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an analysis under § 103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q. (BNA) 1005, 1009-10 (Fed. Cir. 1985). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is however, simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known

purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

As the Court of Appeals for the Federal Circuit noted, “[w]hen a rejection depends upon a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” Ecolchem, Inc. v. Southern Calif. Edison, 56 U.S.P.Q. 2d 1065, 1073 (Fed. Cir. 2000). Here, there is simply no motivation provided in any one of the Thomson et al., Slabonik et al., or Ertel references to combine their teachings. Furthermore, even assuming that such a motivation existed, a combination of these references would not result in the method of processing a customer claim against a manufacturer’s product as described in independent claims 1, 19, and 20.

It is respectfully submitted that the Thomson et al., Slabonik et al., and Ertel references skirt around, but do not suggest the claimed invention *as a whole*. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383 (Fed. Cir. 1986). Further, it is respectfully submitted that one must pick and choose elements from the dissimilar methods disclosed in the Thomson et al., Slabonik et al. and Ertel references and combine these elements by restructuring the methods, using hindsight and applicant’s own disclosure, to conclude that the claimed invention is obvious. Applicant respectfully submits that this would be improper in view of the disclosure of the prior art.

The Thomson et al. publication is directed to processing customer claims for warranty service of consumer goods. More precisely, Thomson et al. is only concerned with whether a product is under warranty or not, and approval or denial of the claim is a simple yes/no determination based solely on that fact. The Examiner acknowledges that Thomson et al. fails to teach approval of warranty claims at multiple management levels based on the value of the claim. Specifically, Thomson et al. does not teach the step of determining the value of a warranty claim, then processing

the claim through three separate management levels based on the value of the claim, as defined in independent claim 1. Similarly, the Thomson et al. publication does not teach a fourth management level that reviews approved claims for accuracy and completeness and informs the customer of a denial. Moreover, Thomson et al. says nothing about any management level that informs and directs an accounting management level to reimburse the customer when a claim is approved as defined in independent claims 19 and 20.

On the other hand, the Slabonik et al. publication is directed to the underwriting process of approving or denying insurance applications. The Examiner suggests that the Slabonik process includes hierarchical levels that can be combined with the Thomson publication. However, Slabonik is concerned with approving or denying insurance to new applicants based on their insurable risk as determined by how the applicant fills out the application, and the “referral” of applications to a secondary underwriter for review of other included information is not necessarily hierarchical. Furthermore, even if the “referral” process steps of Slabonik were somehow hierarchical in nature, it would be unnecessary and redundant to combine the more complex underwriting approval process of insurance applications in Slabonik with the simplistic, yes/no type of warranty approval process in Thomson et al. In short, applicant respectfully submits that there is no motivation to combine these references. Furthermore, even if the methods of Thomson et al. and Slabonik et al. were combined, they would fail to teach the present invention as defined in independent claims 1, 19, and 20.

Neither the Ertel ‘262 patent or the Tidball et al. publication make up for the deficiencies in the teachings of the Thomson et al. or Slabonik et al. The Ertel ‘262 patent automatically detects, analyzes, and classifies the quality and accuracy of coded patient data stored in the hospital databases, and does so in a batch, or bulk, processing format. The Examiner suggests that a combination of the “quality review feature” of the Ertel ‘262 patent with the Thomson et al. and

Slabonik et al. publications renders the fourth management level recited in independent claims 19 and 20, obvious. However, the Applicant respectfully disagrees.

First, as discussed above, there is no motivation to combine Thomson et al. and Slabonik et al. Second, the Ertel '262 patent does not disclose a series of management levels in its review of hospital databases. Further, Ertel does not simply include a "quality review feature," that can be combined with other types of records or claim processing. Ertel is a complete and complex bulk records processing system that specifically relates to error detection in large numbers of patient records stored within a hospital database. Ertel reviews the database records as a whole for coding errors. It does not and cannot process any record individually as would be required in the management of warranty claims. Importantly, the Ertel '262 patent does not disclose or suggest providing a fourth management level that reviews approved customer claims for accuracy and completeness and informs the customer of a denial and then informs and directs an accounting management level to reimburse the customer when a claim is approved as described in independent claims 19 and 20. Thus, the Ertel '262 disclosure does not make up for the deficiencies in Thomson et al. or Slabonik et al. Finally, even if all the elements of the Ertel '262 patent and the Thomson et al. and Slabonik et al. publications were combined, they would fail to teach the present invention as defined in independent claims 1, 19, and 20.

As noted above, Tidball et al. is merely cited as disclosing a web page button. However, the Tidball et al. application is entirely distinct from the other prior art references of record in this case and does not make up for the deficiencies in these disclosures.

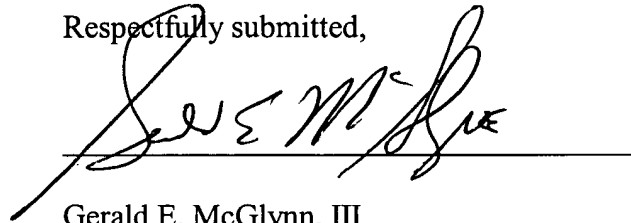
Thus, it is respectfully submitted that independent claims 1, 19, and 20 recite methods that are not disclosed or suggested by the prior art and are patentably distinguishable from the subject matter of the references discussed above. Claims 2 through 18 are all ultimately dependant upon

independent claim 1 and add further perfecting limitations. As such the prior art references in combination or each reference standing alone do not suggest the present invention. However, even if they did, they could only be applied through hindsight after rearranging the disclosure of the prior art in view of applicant's invention. A combination of the prior art in this way to derive applicant's invention would, in and of itself, be an invention.

Conclusion

In view of the above, applicant respectfully submits that the claims are clearly distinguished over the prior art and are therefore allowable. Accordingly, Applicant respectfully solicits the allowance of the claims pending in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald E. McGlynn, III", is written over a horizontal line.

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